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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,140

09/11/2003

Xavier Grobon

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01/25/2005

PATENT OPERATIONS
THOMSON LICENSING INC.
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EXAMINER

NATALINI, JEFF WILLIAM

ART UNIT

PAPER NUMBER

2858

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary

Application No.

10/660,140

Applicant(s)

GROBON, XAVIER

Examiner

Jeff Natalini

Art Unit

2858

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/6/04</u> | 6) <input type="checkbox"/> Other: ____ |

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because figures 1 and 2 only have the numbers in the corresponding boxes, please write in the box what is being represented by the box or illustrate appropriately so that one skilled in the art would know what is being represented. For example fig 1 (26) is a power supply, either write power supply in the box or draw a power supply. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

2. Claim 12 is objected to because of the following informalities:
- It is stated in the claim that when the (characteristics) numbers are equal the result is positive, its is seen in the specification that the conditions are subtracted (pg 7 line 8-13) therefore it would seem if the characteristics are equal the result should be zero.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Najam (5521491).

Najam discloses a method containing a first electrical appliance (transmitting box-abstract) plugged into a first part (fig 6 (105)) of an electrical network (abstract, plugged into a first outlet of a building) and a second electrical appliance (receiving box-abstract) plugged into a second part (fig 6 (107)) of the electrical network (abstract-plugged into the second outlet of the building) wherein: measurement of a specified criterion (zero-cross over-abstract) of the first part by the first electrical appliance from the energizing of the first part up to a transmission/communication of the signal by the appliance (col 7 line 52-57), measurement of a specified criterion on the second part by the second appliance from the energizing of the second part and up to a receipt/communication of a signal from the first appliance (col 7 line 62 - col 8 line 8); comparison of the first characteristic with the second characteristic (abstract).

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus the fact that the intended use of locating a first appliance is not given patentable weight.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Najam (5521491).

In regard to claims 1 and 9, Najam discloses a method containing a first electrical appliance (transmitting box-abstract) plugged into a first part (fig 6 (105)) of an electrical network (abstract, plugged into a first outlet of a building) and a second electrical appliance (receiving box-abstract) plugged into a second part (fig 6 (107)) of the electrical network (abstract-plugged into the second outlet of the building) wherein: measurement of a number of alternations or periods (zero-cross over-abstract) of the first part by the first electrical appliance from the energizing of the first part up to a transmission/communication of the signal by the appliance (col 7 line 52-57), measurement of a second number of alternations or periods on the second part by the second appliance from the energizing of the second part and up to a receipt/communication of a signal from the first appliance (col 7 line 62 - col 8 line 8).

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88

USPQ 478, 481 (CCPA 1951). Thus the fact that the intended use of locating a first appliance is not given patentable weight.

Najam lacks comparison of the first number with the second number.

Najam teaches where each zero-cross-over of the transmitting box is sensed and compared to a comparable zero-cross-over of the receiving box (abstract), so each zero-cross-over transmitted is compared to the zero-cross-over of the receiver, essential comparing the number of zero-cross-overs between the two signals, but determining a phase difference rather than a number difference.

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Najam to compare the number of signals of the first appliance with the number of signals of the second appliance in order to make sure all the corresponding comparisons were done correctly.

In regard to claim 2, Najam discloses an exchange of the first number/second number by a communication between the first appliance and second appliance (col 3 line 8-11).

In regard to claim 3, Najam discloses communication with carrier currents (col 3 line 9-10; through power lines and thus a carrier current).

In regard to claim 4, Najam discloses wherein the signal corresponds to the start signal for communication (col 3 line 18-26; both appliances don't power up until they are plugged in and the comparison is made at the point where the reference packet it received).

In regard to claim 5, Najam discloses wherein a step takes place posterior to the comparison, whose nature depends on the difference between the first number and the second number (col 8 line 13-22).

In regard to claim 6, Najam discloses where the transmission of said signal is a specified duration (col 8 line 23-32 and the duration of each period (3 ms) is defined in col 7 line 57-58).

In regard to claim 7, Najam lacks specifically stating the duration is between 1 s and 20s.

Najam teaches that possibilities exist that could lengthen the duration (col 8 line 27-32), (currently 50 samples at 3ms). It would have been obvious to one with ordinary skill in the art at the time the invention was made to lengthen the duration to 1s – 20 s in order to eliminate false data (col 8 line 31-32).

In regard to claim 8, Najam discloses the duration has a least a random component (col 8 line 54-67, instead of digital data a monotone signal may be used which is able to contain random data).

7. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Najam (5521491) in view of Citta (4553161).

In regard to claims 11 and 12, Najam discloses all as applied to the 35 U.S.C. 102 (b) rejection of claim 10 above.

Najam lacks wherein decryption is done if and only if the result of the comparison is positive; wherein the result is positive if and only if the first characteristic is equal to the second characteristic.

Citta teaches comparing a transmitted data signal with a data signal that is stored on a receiver system (abstract), in this invention it is disclosed that a match between the signal transmitted and the stored signal permits decryption (col 4 line 50-54).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Najam to perform decryption if the first signal (characteristic) is equal to the second signal (characteristic) whether this is read as positive or zero in order to accurately synchronize upstream data (abstract last sentence).

In regard to claim 13, Najam discloses wherein the comparison is positive when the characteristic differs by less than a tolerance value (col 4 line 45-60; the differences are known (positive values of time) and can be compared accordingly to determine result).

In regard to claim 14, Najam discloses communication with carrier currents (col 3 line 9-10; through power lines and thus a carrier current).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Najam (5521491) in view of Citta (4553161) as applied to claim 11 above, and further in view of Diehl et al. (Publication 2003/0108206).

Najam as modified lacks wherein the first and second appliances are digital decoders.

Diehl et al. teaches digital decoders are able to receive data from a satellite or cable connection, and transmit that signal to an appropriate device (paragraphs 4 and 5).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Najam as modified to use as the two appliances digital decoders in order to process and present data to a user (paragraph 4).

9. Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Najam (5521491) in view of Citta (4553161) as applied to claim 11 above, and further in view of admitted prior art.

Najam as modified infers that carrier currents are used for communication (see prior rejection of claims 2 and 14).

Admitted prior art specifically discloses that it is known for electrical appliances in the same network to communicate with carrier currents (pg 1 line 23-25).

It would have been obvious to one with ordinary skill in the art at the time the invention was made for Najam as modified to communicate with carrier currents as taught by the admitted prior art in order to make appliances on the same network hold a dialogue with one another.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harney (3882392) discloses a system that has multiple receivers

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that decode a digital signal from a central station. Laor (6002331) teach transmitting information to a controller (receiver) that provides the system operator with information on the communication line.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Natalini whose telephone number is 571-272-2266. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeff Natalini



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